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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,053	02/02/2005	Stanley George Bonney	P33090 USW	7571
23347	7590	03/20/2008		
GLAXOSMITHKLINE CORPORATE INTELLECTUAL PROPERTY, MAI B475 FIVE MOORE DR., PO BOX 13398 RESEARCH TRIANGLE PARK, NC 27709-3398			EXAMINER JACYNA, J CASIMER	
			ART UNIT 3754	PAPER NUMBER
			NOTIFICATION DATE 03/20/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USCIPRTP@GSK.COM  
JULIE.D.MCFALLS@GSK.COM  
LAURA.M.MCCULLEN@GSK.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,053	<b>Applicant(s)</b> BONNEY, STANLEY GEORGE	
	<b>Examiner</b> J. Casimer Jacyna	<b>Art Unit</b> 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,7,8,10-29,32-34,36,38 and 45-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7,8,10-29,32-34,36,38 and 45-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1, 2, 5, 7, 8, 10-29, 32-34, 36, 38 and 45-52 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18, 20-31 and 35-44 of copending Application No. 10/522,996. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both drawn to the same dispenser for dispensing a metered volume of a fluid product wherein all of the elements called for in application '996 claim 1, the storage chamber, metering chamber, outlet, boundary wall structure, actuation mechanism, first and second phases or states with a bleed arrangement are all found in this application claim 34. Claim 34 of this application contains a larger combination of elements and additionally includes a third state, a plunger structure and defining the fluid as a medicament that not called for in application '996 claim 1. However, as stated in MPEP 806.05(a) when there are two claims drawn to the same subject matter with one including a combination of a larger number of elements, the criteria for restriction or to define patentable distinctness between the claims is that the combination claim cannot require the details of the subcombination claim. Since in this case the combination claim 34 of this application includes all of the details of subcombination claim 1 in the '996 application, the two claims are not patentably distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1, 2, 5, 7, 8, 10-29, 32-34, 36, 38 and 45-52 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over German DE 100 17 438. As noted in the PCT preliminary examination report

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dated 9/20/2004 DE/438 discloses a dispenser including a storage chamber 2, an outlet orifice 13, 35, a metering chamber 7, an outlet opening 18, a bleed arrangement 22 and a dispensing mechanism 3, 31 that functions as claimed as explained in the report. In regard to the functional language regarding three positions and two volumetric states, DE has the same claimed shape and is capable of being used in three different positions with two different volumes as claimed. Whether or not the dispenser of DE is used in this fashion depends on a future act of use and not on any claimed structural difference. In regard to the bleed arrangement, DE discloses a dispenser with the same claimed piston in a piston chamber with a side inlet wherein because the piston moves past the side inlet in the same manner as disclosed it must inherently perform the same function of bleeding material back into the storage chamber.

6. Claims 1, 2, 5, 7, 8, 10-15, 18-29, 32, 33, 36, 38 and 45-52 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Voellmicke et al. (7,008,433). Voellmicke discloses a dispenser including a storage chamber 3, an outlet orifice 27, a metering chamber 21, an outlet opening at the base of 27, a bleed arrangement 5, 25, and a dispensing mechanism 35, 39 wherein the device can take various positions as shown at A, C, B2 and B3. In regard to the functional language regarding three positions and two volumetric states, Voellmicke has the same claimed shape and is capable of being used in three different positions with two different volumes as claimed. Whether or not the dispenser of Voellmicke is used in this fashion depends on a future act of use and not on any claimed structural difference. In regard to the bleed arrangement, Voellmicke discloses a dispenser with the same

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claimed piston in a piston chamber with a side inlet wherein because the piston moves past the side inlet in the same manner as disclosed it must inherently perform the same function of bleeding material back into the storage chamber.

7. Claims 1, 2, 5, 7, 8, 10-15, 18-29, 32, 33, 36, 38 and 45-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Spaude et al. (4,077,494). Spaude discloses a dispenser including a storage chamber 2, an outlet orifice 45, a metering chamber 39, an outlet opening 34, a bleed arrangement 42, and a dispensing mechanism 41, 38.

The dispenser of Spaude is capable of being used in the manner claimed regardless of whether or not Spaude discloses the actual positions. A user could push piston 40 past opening 42 to isolate a metered dose based on the height of piston 40 above the housing 28 and then dispense as claimed. Whether or not the apparatus is used in this manner depends on a future act of use and not on any claimed structural difference. In regard to the bleed arrangement, Spaude discloses a dispenser with the same claimed piston in a piston chamber with a side inlet wherein because the piston moves past the side inlet in the same manner as disclosed it must inherently perform the same function of bleeding material back into the storage chamber.

8. Claims 1, 2, 5, 7, 8, 10-15, 18-29, 32-34, 36, 38 and 45-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Engseth (2,435,647). Engseth discloses a dispenser including a storage chamber 11, an outlet orifice 41, a metering chamber 12, an outlet opening at 42, a bleed arrangement 26, a boundary wall structure as is plunger 13, and an actuation mechanism 45 that is biased by spring 57, 61 into the

position shown in figure 1 where the dispenser is in the second configuration that closes the bleed arrangement 26 (see column 4, lines 28-31).

9. Claims 1, 2, 5, 7, 8, 10-15, 18-29, 32, 33, 36, 38 and 45-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis (2,497,762). Davis discloses a dispenser including a storage chamber 10, an outlet orifice 24, a metering chamber 16, an outlet opening at 26, a bleed arrangement 22, a boundary wall structure as is plunger 20 that has a low volume position as shown in figure 3 and a large volume position shown in figure 4 and an actuation mechanism 30 wherein the device has a rest position as shown in figure 1 where the dispenser is in the second configuration that closes the bleed arrangement.

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dirksen (2,650,744) teaches another metering dispenser.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Casimer Jacyna whose telephone number is 571-272-4889. The examiner can normally be reached on Wed. thru Fri. 9AM-7PM, Mon. 7AM-1PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. Casimer Jacyna/

Primary Examiner, Art Unit 3754